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OFFICE OF PETITIONS

In re Application of :
Joseph Kuriacose, Ansley Jessup : DECISION
Vincent Dureau and Alain Delpuch : ON PETITION
Application No. 09/672,523 :
Filed: September 27, 2000 :
Atty Docket No. 2050.001US3 :

This reissue application is before the Office of Petitions, for consideration of the "PETITION UNDER 37 C.F.R. §1.183" filed February 20, 2012.

In this instance, waiver is sought with respect to the requirement in view of 37 CFR §§ 1.67, 1.172 and 1.175 that a supplemental declaration be executed by the named inventors in a broadening reissue application.

The \$400 fee for such consideration is being charged to petitioner's Deposit Account, as authorized.

The petition is **DISMISSED**.

BACKGROUND

The present reissue application of patent No. 5,819,034 (issued October 6, 1998) was filed on September 27, 2000, by the assignee as a broadening reissue application. On November 8, 2000, the Office mailed a Notice to File Missing Parts of Reissue Application, requesting a signed oath or declaration, a late surcharge, and a written consent of assignee. A reply was filed on December 19, 2000; however, it did not include a written consent of assignee and a § 3.73(b) statement.

By non-final Office action mailed November 18, 2009, the examiner advised applicants that the Substitute reissue declaration filed March 30, 2009 is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. Specifically, the filed substitute declaration was said to not identify the existence of an error in the specification, drawings, or claims, which error causes the original patent to be defective.

After a series of petitions directed to the Technology Center and decisions therein, filing of a notice of appeal and rendering of a favorable decision by the Board of Patent Appeals and Interferences on June 13, 2011, on February 20, 2012, applicants filed the instant petition seeking permission to file this application without the signature of joint inventor Ansley Wayne Jessup. Applicants state that we are unable to obtain his signature on the supplemental reissue declaration.

DECISION

35 U.S.C. 251, which is directed to reissue, does not address the signature requirements of a declaration in reissue. 37 CFR § 1.172 requires that a reissue declaration be made (and signed) by the inventors, except as otherwise provided (§§ 1.42, 1.43, 1.47), where the scope of the claims of the original patent is being enlarged. 37 CFR 1.175(b)(1) requires that:

For any error corrected, which is not covered by the oath or declaration submitted under paragraph (a) of this section, applicant must submit a supplemental oath or declaration stating that every such error arose without any deceptive intention on the part of the applicant.

37 CFR 1.175(b)(1), taken in conjunction with § 1.172, requires a supplemental declaration to be signed by the inventor. This is because all oaths or declarations necessary to fulfill the rule requirements in a reissue application are taken together collectively as a single oath or declaration. Thus, each oath and/or declaration must bear the appropriate signature of the inventor.

37 CFR 1.183 permits, in an extraordinary situation, waiver of a rule which is not a requirement of the statute, where justice requires such waiver, and applicant has requested a waiver of

the requirement that the 37 CFR 1.175(b)(1) supplemental declaration be signed by all of the inventors.

While 37 CFR 1.47(a) is not directly applicable to the current set of facts, it does provide an analogous analysis as to the required showing to rectify situations involving a non-signing legal representative as to a declaration. As such a 37 CFR 1.47(a) analysis will be applied, to the extent applicable, such that justice requires the waiver of the rules in this situation.

In addition to other requirements of law (35 U.S.C. 111(a) and 115), an application deposited in the U.S. Patent and Trademark Office pursuant to 37 CFR 1.47(a) must meet the following requirements:

- (A) All the available joint inventors must
 - (1) make oath or declaration on their own behalf as required by 37 CFR 1.63 or 1.175¹ (see MPEP § 602, § 605.01, and § 1414) and
 - (2) make oath or declaration on behalf of the nonsigning joint inventor as required by 37 CFR 1.64. An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.
- (B) The application must be accompanied by proof that the nonsigning inventor
 - (1) cannot be found or reached after diligent effort
 - (2) refuses to execute the application papers. See MPEP § 409.03(d).
- (C) The last known address of the nonsigning joint inventor must be stated. See MPEP § 409.03(e).

¹ However, the question of the sufficiency of the reissue oath/declaration filed under 37 CFR 1.175 must in each case be reviewed and decided personally by the primary examiner.

Applicants have submitted a supplemental reissue declaration executed by joint inventors Kuriacose Joseph, Vincent Dureau and Alain Delpuch on behalf of themselves and on behalf of nonsigning joint inventor Jessup. The petition states that the request to sign the declaration was sent to the nonsigning inventor's last known address. Thus, the last known address of the nonsigning inventor is deemed to be the address set forth on the FedEx delivery confirmation receipt (and on the supplemental reissue declaration).

However, the petition must be dismissed because it does not include adequate proof of the nonsigning inventor's refusal to execute the supplemental reissue declaration. The petition includes a showing that the substitute reissue declaration was presented by email and federal express delivery to inventor Jessup. The petition does not include an express refusal by the inventor. Rather, applicants seek to have the Office infer refusal by conduct. Such an inference cannot be made where as here it is not shown that the inventor was presented with all of the application papers. As stated in MPEP 409.03,

a refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the 37 CFR 1.47 applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See MPEP 106. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the

application to which the oath or declaration is directed.
In re Gray, 115 USPQ 80 (Comm'r Pat. 1956).

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient.

CONCLUSION

In view thereof, the petition is dismissed.

In order for this petition to be granted, applicants must show that all of the application papers were presented to inventor Jessup, and that he refused expressly or by conduct to execute the supplemental reissue declaration. A supplemental reissue declaration executed by inventor Jessup is also a proper response to this decision.

Applicants are given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.183," and should only address the deficiencies noted herein, except that the reply may include an oath(s) or declaration(s) executed by the non-signing inventor. This period is governed by 37 CFR 1.181(f) and is not extendable.

Further correspondence with respect to this decision should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By fax: (571) 273-8300
 ATTN: Office of Petitions

By hand: Customer Service Window
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Telephone inquiries regarding this decision should be directed to Senior Petitions Attorney, Nancy Johnson at (571) 272-3219.

A handwritten signature in black ink, appearing to read 'Anthony Knight', is written over the printed name.

Anthony Knight
Director
Office of Petitions